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January 20, 2010
Date

REQUEST FOR REHEARING PURSUANT TO 37 C.F.R. § 41.52

This is a request for rehearing of the decision of the Board of Patent Appeals and Interferences in the above-identified application dated November 20, 2009. In the decision, the Board

- overruled the rejection of claims 22-29 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement
- affirmed the rejection of claims 22-24 and 26-28 under 35 U.S.C. § 102(e) as being anticipated by Miller
- affirmed the rejection of claims 22-24 and 26-28 under 35 U.S.C. § 102(e) as being anticipated by Gilbert
- affirmed the rejection of claim 25 under 35 U.S.C. § 103(a) as being unpatentable over Miller and Kondo
- affirmed the rejection of claim 25 under 35 U.S.C. § 103(a) as being unpatentable over Gilbert and Kondo
- affirmed the rejection of claims 29 and 30 under 35 U.S.C. § 103(a) as being unpatentable over Margalit and Jha.

The rejected claims are reproduced in the Appendix A attached hereto.

While the Board correctly overruled the rejection of claims 22-29 as failing to meet the written description requirement of § 112, first paragraph, in its analysis of claim 22 the Board misapprehended the interpretation of the limitation “a non-volatile solid-state memory . . . having sufficient capacity to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD.” The Board’s misapprehension of the interpretation of this limitation led the Board to incorrectly sustain the rejections of the claims under § 102(e) and § 103(a). The Board also misapprehended the disclosure of the Gilbert reference. The contents of the memory of the Gilbert reference cannot be modified, thus the device disclosed in Gilbert is not a portable data storage device that can serve as an alternative to a magnetic disk or CD.

Appellants respectfully request the Board to correct its misapprehension of the interpretation of the limitation “a non-volatile solid-state memory . . . having sufficient capacity to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD” and to apply the correct interpretation of this limitation in its analysis of the rejections in view of the cited prior art. Appellants also respectfully request that the Board correct its misapprehension of the disclosure of the Gilbert reference. Appellants respectfully submit that correctly construed, claims 22-30 are supported by the written description and allowable over the cited prior art. Appellants also respectfully submit that as correctly viewed, the disclosure of Gilbert does not anticipate claims 22-24 and 26-30.

I. SUMMARY OF THE CLAIMED SUBJECT MATTER

Appellants’ invention is directed to a portable data storage device that plugs directly into a computer’s Universal Serial Bus (USB) port. *See* Specification, pg. 1, lines 3-4; pg. 1, line 24 to pg. 2, line 4; pg. 5, lines 18-19. The portable data storage device of the present invention provides advantages over conventional data storage devices, which generally fall

into two categories. *See* Specification, pg. 1, line 6 to pg. 2, line 11. The first category is electronic, solid-state memory devices such as read-only memories (ROMs) and random access memories (RAMs). *See* Specification pg. 1, lines 6-11. These prior art memory devices are typically internal to a computer and are not removable or portable. *See id.* The second category of prior art memory devices is surface-based data storage devices in which data is typically stored on the surface of, e.g., a magnetic disk or a Compact Disk (CD). *See* Specification, pg. 1, lines 13-22. The prior art memory devices falling into this second category typically require a mechanical drive mechanism to read the data on them. *See id.* The combination of these storage devices and the drive mechanism is generally bulky and/or delicate because of the moving parts in them. *See id.*

The portable data storage device according to the present invention functions portably like a magnetic disk or a CD but eliminates the moving parts and the mechanical drive mechanism by employing as its storage media the electronic, solid-state memory devices. *See* Specification pg. 1, line 24 to pg. 2, line 11. Thus the portable data storage device contains a solid-state memory device and the means to access the memory device (a memory controller) in one portable unit. The non-volatile solid-state memory device can store user data and/or packaged software for installation on a computer. Specification, pg. 4, lines 21-22.

As illustrated in Figure 1 of the parent PCT application, reproduced below, the portable data storage device 10 according to the present invention includes a USB plug 1, which is coupled to a USB interface device 2, which is coupled to a micro-controller 3, which is coupled to a flash memory 4. *See* International PCT application No. PCT/SG00/00029, (priority application for the present national phase application, reproduced as Appendix B3: Evidence Appendix to the Appeal Brief), Specification pg. 3, lines 22-24. The micro-controller 3 includes a read-only memory (ROM) 5, which stores a program to

control the operations of the micro-controller 3. See Specification pg. 3, line 24 to page 4, line 2.

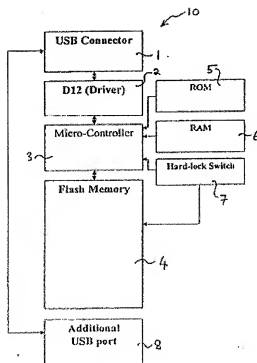


Figure 1. Appellants' PCT Application

II. POINTS BELIEVED TO BE MISAPPREHENDED BY THE BOARD

A. Interpretation of "Sufficient Capacity" Limitation

Claim 22 recites "a non-volatile solid state memory . . . having sufficient capacity to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD." In correctly determining that this limitation is supported by adequate written description, the Board interpreted the limitation as not requiring a specific amount of storage capacity. Appellants respectfully submit that while the Board correctly found that this limitation is supported by adequate written description, the Board's interpretation of the term "capacity" was in error.

To comply with 35 U.S.C. § 112, ¶ 1, “the disclosure need only reasonably convey to persons skilled in the art that the inventor had possession of the subject matter in question.” *Fujikawa v. Wattanasin*, 93 F.3d 1159, 1570 (Fed. Cir. 1996); *Fiers v. Revel*, 984 F.2d 1164, 1170 (Fed. Cir. 1993); *In re Kaslow*, 707 F.2d 1366, 1375 (Fed. Cir. 1983); *see also Vas-Cath v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). “The [Federal Circuit] and its predecessor have repeatedly held that claimed subject matter ‘need not be described *in haec verba*’ in the specification to satisfy the written description requirement.” *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916, 922-23 (Fed. Cir. 2004). When the express or inherent support in the specification is not present, implicit support in the disclosure will suffice. *See* MPEP 2163(I)(B) (8th ed., August 2006) (“While there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure.”). Particularly, “the absence of definitions or details for well-established terms or procedures should not be the basis of a rejection under 35 U.S.C. 112, paragraph 1, for lack of adequate written description.” MPEP 2163(II)(A)(1) (8th ed., August 2006).

The Board found that the application’s disclosure contrasts the claimed portable data storage device from the prior art storage devices such as magnetic disks and CDs by the portable data storage device’s portability and lack of moving parts. *See* Decision pg. 8. In view of this and its analysis of the disclosure regarding other claim limitations at issue, the Board properly overruled the Examiner’s rejection of claims 22-29 under § 112, first paragraph. *See* Decision pg. 9.

But in its analysis regarding the limitation “a non-volatile solid state memory . . . having sufficient capacity to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD,” the Board stated that “we do not see why the ‘capacity,’ if interpreted to refer to an amount of memory, requires more than a single byte

(or bit) of memory, in light of the teachings of the Specification.” See Decision, pg. 8.

Appellants respectfully submit that this interpretation is incorrect in view of the specification.

As the Board found, the specification, by first describing the shortcomings of magnetic disks or CDs and then introducing the advantage of the claimed invention over such magnetic disks or CDs, clearly discloses that the portable data storage device is to serve as an alternative to magnetic disks or CDs.¹ To serve as a viable alternative to a magnetic disk or CD, the portable data storage device must provide a memory having at least substantially the same amount of capacity as that of a magnetic disk or CD. At the time of the invention it was known in the art that a magnetic disk or CD had at least about a megabyte of capacity.² The Board’s determination that the portable data storage device’s memory could have a capacity of as little as a single bit or byte contradicts the intention clearly disclosed in the specification. If the non-volatile memory had a capacity of only a single bit or byte, it would not have sufficient capacity to enable the portable data storage device to serve as an alternative to a magnetic disk or CD. Hence, by unambiguously disclosing the intention for the claimed invention to serve as an alternative to magnetic disks and CDs, the specification has expressly, implicitly, or inherently supported the claimed invention’s storage capacity to be at least substantially the same as that of a magnetic disk or CD.

The non-volatile memory’s disclosed capability of storing software for installation on a computer also demonstrates that the disclosed capacity of the non-volatile memory enables

¹ “[M]agnetic disks and CD ROMs . . . require a mechanical drive mechanism to be installed in or coupled to the computer to permit the data on the storage device to be read by the computer. . . . [T]he combination of the storage device and the drive mechanism for reading data from the storage device is generally bulky and/or delicate due to the moving parts that are required within the drive mechanism and/or storage device. . . . An advantage of the invention is . . . to provide a portable data storage device . . . which does not include moving parts or require a mechanical drive mechanism to read the data from the data storage device.” See Specification, pages 1-2.

² This would put a *lower limit* of the storage capacity of the claimed invention of about 1.44 MB, the capacity of the floppy disk it was designed to replace. That is, the claimed device would have at least about 1.44 MB of memory capacity to serve as an alternative to the 1.44 MB floppy disk.

the portable data storage device to serve as an alternative to a magnetic disk or CD. The specification discloses that the non-volatile memory of the portable data storage device can store software for installation on a computer: “[T]he data storage device 10 is supplied with packaged software,” (Specification, pg. 4, lines 21-22); “[t]he device 10 assumes that the user wishes to install software on the computer which is stored in flash memory 4” (Specification, pg. 7, lines 1-4). Appellants respectfully submit that at the time of the invention it was well-known in the art that software for installation on a computer could be supplied on a magnetic disk or a CD and that most, if not all, software for installation on a computer comprised more than one byte or one bit of data. The non-volatile memory of the portable data storage device is disclosed as being capable of storing software for installation on a computer, and thus the specification discloses that the non-volatile memory of the portable data storage device has a capacity sufficient to store such software.

Appellants respectfully submit that the word “capacity,” when applied to a memory device as in claim 22, plainly and ordinarily means the storage capacity of the memory, i.e., how much data the memory can store. The Board’s statement that “capacity” as used in claim 22 can refer to “data transfer rate” stretches the meaning of the term beyond its plain and ordinary meaning.

Appellants have clearly and reasonably conveyed to those skilled in the art that Appellants were in possession of a unitary portable data storage device having a memory with sufficient capacity to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD. As the Board correctly found, claims 22-29 comply with the requirement under 35 U.S.C. § 112, first paragraph in terms of “sufficient capacity.” In view of the disclosure in the specification, Appellants respectfully submit that the Board should acknowledge that properly construed, the limitation “sufficient capacity to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD”

means sufficient capacity to store at least an amount of data substantially similar to the amount of data capable of being stored by a magnetic disk or CD.

B. Disclosure of Gilbert

The Board misapprehended the disclosure of Gilbert. Gilbert does not disclose a portable data storage device capable of serving as an alternative to a magnetic disk or CD. Gilbert discloses a programmable dedicated application card (PDAC) that executes dedicated software applications stored in the PDAC. The PDAC is intended to provide protection to a software application: “Because a software application is stored in EPROM, the application cannot be tampered with or otherwise tainted.” Gilbert, col. 2, lines 18-19. Gilbert discloses that to upgrade to a new version of the software application, an existing PDAC cannot be modified but would have to be replaced by a totally new PDAC. Gilbert, col. 2, lines 22-25. The preferred embodiment specifically discloses storing the software application in an EPROM because an EPROM “cannot be accidentally reprogrammed,” or overwritten. *See, e.g.*, Gilbert, col. 3, lines 37-39. Any other type of memory used in the PDAC must allow the PDAC to “function and operate as intended,” and the PDAC is clearly intended to store an application such that the application cannot be modified or overwritten. Gilbert, col 3, lines 39-48. Thus Gilbert clearly discloses a device for executing a software application that is stored in a memory whose contents cannot be modified by a user. Because the contents of the memory of the PDAC of Gilbert cannot be modified, Gilbert does not disclose a portable data storage device capable of serving as an alternative to a magnetic disk or CD.

III. THE REJECTIONS IN VIEW OF THE PRIOR ART MUST BE OVERRULED IN VIEW OF THE CORRECT INTERPRETATION OF THE “SUFFICIENT CAPACITY” LIMITATION AND THE DISCLOSURE OF THE GILBERT REFERENCE

A. Rejections under § 102(e)

1. Miller

The Examiner rejected claims 22-24 and 26-28 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,038,320 to Miller (“Miller”). Appellants respectfully submit that in view of the correct interpretation of the limitation “a non-volatile solid state memory . . . having sufficient capacity to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD,” Miller does not disclose each and every limitation of claims 22-24 and 26-28.

Claim 22 recites a unitary portable data storage device having, among other elements, “[a] memory being non-removable from the unitary portable data storage device and having sufficient capacity to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD” as well as “[a] memory controller being coupled between the interface and the memory to control the flow of data between the memory and the USB plug in a manner to enable the unitary portable data storage device to operate as an alternative to a magnetic disk or CD.” These limitations are structural limitations because they describe physical characteristics of the claimed device: the capability to manage the flow of large amounts of data and the sufficient memory capacity to serve as an alternative to a magnetic disk or CD.³ As explained above, the limitation of “sufficient capacity to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD,” when properly construed in view of the specification, means sufficient capacity to store at least an amount of data substantially similar to the amount of data capable of being stored by a magnetic disk or CD.

³ Appellants respectfully note that functional terms serve as structural limitations when they are used as adjectives to define the physical characteristics of the device. See *United States Filter Corp. v. Glegg Water Conditioning, Inc.*, 2005 WL 80947, *1 (D. Mass.); *In re Garnero*, 412 F.2d 276 (CCPA 1969). See also *Vanguard Products Corp. v. Parker Hannifan Corp.*, 234 F.3d 1370, 1372 (Fed. Cir. 2000); *Hazani v. U.S. Int'l Trade Comm'n*, 126 F.3d 1473, 1477 (Fed. Cir. 1997).

Miller discloses a security key that must be coupled to the USB bus of a specially programmed host computer in order for the user to obtain access to the computer, i.e., for the computer to successfully boot and be operational. *See, e.g.*, Miller, col. 2, lines 20-28; col. 4, lines 42-51; col. 5, lines 5-7; Fig. 6, steps 130, 140, and 170. The purpose of Miller's security key is to provide security to a host computer that includes a USB port by preventing a keyboard attached to the USB port from bypassing run-time security enabled by a keyboard controller. Miller, col. 2, lines 3-16. Miller's security key is not a portable data storage device, and there is no disclosure in Miller that the security key can serve or is intended to serve as an alternative to a magnetic disk or CD.

Miller does not teach or disclose that the flash memory of the security key stores anything other than the key code and an encrypted password, and does not teach or disclose that the flash memory of the security key has sufficient capacity to serve as an alternative to a magnetic disk or CD. The memory of the computer security key of Miller is intended only to store a key code and an encrypted password, each of which requires only bytes of data. For example, Miller discloses a password having only six bytes. Miller, col. 3, line 43. At the time of the invention, it was known in the art that a magnetic disk or a CD each had a capacity of at least about a megabyte. Miller does not teach or disclose that the computer security key has a memory with a capacity of at least about a megabyte, and does not teach or disclose that any data stored by the computer security key has a size of about a megabyte. Thus Miller does not teach or disclose a portable data storage device that comprises a "non-volatile solid-state memory having sufficient capacity to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD."

In addition, Miller does not disclose a memory controller coupled to the memory to control the flow of data between the memory and the USB plug. Miller does not disclose a memory controller that is capable of controlling data flow to and from a memory having

sufficient capacity to serve as an alternative to a magnetic disk or CD. The memory controller recited in claim 22 is capable of controlling the flow of data that can be stored in a memory having the capacity to serve as an alternative to a magnetic disk or CD. In contrast, Miller discloses a USB controller. *See* Miller, Fig. 3, element 42; col. 2, line 64 – col. 3, line 2. Miller does not teach that the USB controller can control data flow to and from a memory having sufficient capacity to serve as an alternative to a magnetic disk or CD. Because Miller's security key does not include such a memory, there would be no need for the security key to include a controller capable of controlling the flow of data to and from such a memory and Miller does not disclose one.

Appellants respectfully submit that Miller does not disclose all of the limitations of claim 22 and thus claim 22 is allowable. Claims 23-30 depend from claim 22, and are therefore allowable for at least the same reasons.

2. Gilbert

The Examiner rejected claims 22-24 and 26-28 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,457,099 to Gilbert ("Gilbert"). Appellants respectfully submit that in view of the correct interpretation of the limitation "a non-volatile solid state memory . . . having sufficient capacity to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD" and the correct reading of the disclosure of Gilbert, Gilbert does not disclose each and every limitation of claims 22-24 and 26-28.

Gilbert discloses a programmable dedicated application card (PDAC) that executes dedicated software applications stored in the PDAC. The PDAC is intended to provide protection to a software application: "Because a software application is stored in EPROM, the application cannot be tampered with or otherwise tainted." Gilbert, col. 2, lines 18-19. Gilbert discloses that to upgrade to a new version of the software application, an existing PDAC cannot be modified but would have to be replaced by a totally new PDAC. Gilbert,

col. 2, lines 22-25. The preferred embodiment specifically discloses storing the software application in an EPROM because an EPROM “cannot be accidentally reprogrammed,” or overwritten. *See, e.g.*, Gilbert, col. 3, lines 37-39. Any other type of memory used in the PDAC must allow the PDAC to “function and operate as intended,” and the PDAC is clearly intended to store an application such that the application cannot be modified or overwritten. Gilbert, col 3, lines 39-48. Thus Gilbert clearly discloses a device for executing a software application that is stored in a memory whose contents cannot be modified by a user.

Gilbert does not disclose a portable data storage device which is operative to function as an alternative to a magnetic disk or CD including “a non-volatile solid state memory . . . having sufficient capacity to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD,” as recited in claim 22. To serve as an alternative to a magnetic disk or CD, the portable data storage device must be capable of storing user data written to it. Gilbert does not disclose that the PDAC is capable of storing user data written to it. In contrast, the purpose of the PDAC of Gilbert is to execute a software application stored on the PDAC, and the memory of the PDAC cannot be overwritten or otherwise modified. In fact, as stated above, to obtain and use an upgraded version of a software application stored in a PDAC, that PDAC cannot be modified and the user must obtain a totally new PDAC device. Thus the PDAC of Gilbert cannot serve as an alternative to a magnetic disk or CD, and Gilbert does not disclose the portable data storage device of claim 22.

Claim 22 also recites a “memory controller being coupled between the interface and the memory to control the flow of data between the memory and the USB plug in a manner to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD.” Gilbert does not disclose that data can flow between a non-volatile memory and a USB plug to enable the PDAC to serve as an alternative to a magnetic disk or CD. Gilbert clearly

discloses that the contents of the EPROM of the PDAC cannot be modified, so Gilbert does not disclose any flow of data between the EPROM and a USB plug. Thus Gilbert does not disclose the memory controller recited in claim 22.

Appellants respectfully submit that Gilbert does not disclose all of the limitations of claim 22 and thus claim 22 is allowable. Claims 23-30 depend from claim 22, and are therefore allowable for at least the same reasons.

B. Rejections under § 103(a)

1. Miller in view of Kondo

The Examiner rejected claim 25 under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of U.S. Patent No. 6,786,417 to Kondo ("Kondo"). Appellants respectfully submit that Miller in view of Kondo does not render claim 25 obvious. Appellants respectfully submit that in view of the correct interpretation of the limitation "a non-volatile solid state memory ... having sufficient capacity to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD," Miller does not disclose each and every limitation of the parent claim 22 and thus does not disclose each and every limitation of claim 25, which depends from claim 22 and incorporates all of its limitations.

As set forth above regarding claim 22, Miller discloses a security key to provide security to a host computer that includes a USB port by preventing a keyboard attached to the USB port from bypassing run-time security enabled by a keyboard controller. Miller's security key is not a portable data storage device having a memory with sufficient capacity enable the portable data storage device to serve as an alternative to a magnetic disk or CD. Thus, Miller does not teach or disclose a portable data storage device that includes a "non-volatile solid-state memory ... having sufficient capacity to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD."

Neither Miller nor Kondo, alone or in combination, discloses all of the limitations of claim 25. Thus Appellants respectfully submit that claim 25 is not obvious in view of Miller and Kondo and is in condition for allowance.

2. Gilbert in view of Kondo

The Examiner rejected claim 25 under 35 U.S.C. § 103(a) as being unpatentable over Gilbert in view of Kondo. Appellants respectfully submit that Gilbert in view of Kondo does not render claim 25 obvious. Appellants respectfully submit that in view of the correct interpretation of the limitation “a non-volatile solid state memory ... having sufficient capacity to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD” and the correct reading of the disclosure of Gilbert, Gilbert does not disclose each and every limitation of the parent claim 22 and thus does not disclose each and every limitation of claim 25, which depends from claim 22 and incorporates all of its limitations.

As set forth above regarding claim 22, Gilbert does not disclose a portable data storage device which is operative to function as an alternative to a magnetic disk or CD including “a non-volatile solid state memory . . . having sufficient capacity to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD.” The PDAC of Gilbert is clearly intended to store an application such that the application cannot be modified or overwritten. In other words, Gilbert’s PDAC cannot serve as an alternative to a magnetic disk or CD because its very purpose is to protect its pre-stored software application. User data cannot be written to the PDAC and stored on it. Thus Gilbert does not teach or disclose a portable data storage device that includes a “non-volatile solid-state memory having sufficient capacity to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD.”

Neither Gilbert nor Kondo, alone or in combination, discloses all of the limitations of claim 25. Thus Appellants respectfully submit that claim 25 is not obvious in view of Gilbert and Kondo and is in condition for allowance.

3. Margalit in view of Jha

The Examiner rejected claims 29 and 30 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,748,541 to Margalit (“Margalit”) in view of U.S. Patent No. 6,407,949 to Jha (“Jha”). Appellants respectfully submit that Margalit in view of Jha does not render claims 29 and 30 obvious. Appellants respectfully submit that in view of the correct interpretation of the limitation “a non-volatile solid state memory ... having sufficient capacity to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD,” Margalit does not disclose each and every limitation of the parent claim 22 and thus does not disclose each and every limitation of claims 29 and 30, which depend from claim 22 and incorporate all of its limitations. Further, one of ordinary skill in the art would have no reason to modify the device of Margalit to include a set of flash macros as disclosed by Jha.

Margalit discloses a plug device, to be used by mobile users to interact with flexibly connectible computer systems (“FCCS”). *See, e.g.,* Margalit, col. 2, lines 9-18; lines 22-29. Margalit’s FCCS plug device is designed to store mobile user identity information such as “identity authentication information, banking information, access rights information etc.” *See* Margalit, col. 6, lines 29-32.

Margalit does not disclose a portable data storage device which is operative to function as an alternative to a magnetic disk or CD including “a non-volatile solid state memory ... having sufficient capacity to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD.” Although, as the Board noted, Margalit discloses that the plug device can store confidential medical information (col. 7, lines 13-16),

there is no disclosure that storage of this information requires a memory “having sufficient capacity to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD.” Margalit also does not disclose that this confidential medical information is stored in a “non-volatile solid state memory” in the plug device. Thus Margalit does not teach or disclose a portable data storage device that includes a “non-volatile solid-state memory having sufficient capacity to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD.”

Moreover, Margalit does not disclose a memory controller coupled to a memory to control the flow of data between a memory having sufficient capacity to serve as an alternative to a magnetic disk or CD and a USB plug. Margalit discloses a microprocessor (col. 4, lines 59-64), not a memory controller. Thus Margalit does not disclose the memory controller of claims 29 and 30.

Jha discloses a mobile communication device that includes a flash memory divided into a set of flash macros that can be independently accessed. Jha, col. 3, lines 44-45. These independently-accessible flash macros are advantageous in a cellular telephone application because flash memory in a cellular telephone may need to be accessed “much more quickly than is required in other applications,” particularly for voice telephone calls. Jha, col. 2, lines 17-22. One of ordinary skill in the art would have no reason to modify the plug device of Margalit to include a flash memory divided into a set of flash macros. There is no disclosure in Margalit that its memory may need to be accessed “much more quickly” than required in other applications. Thus, there would be no need to add, and no benefit in adding, a memory divided into a set of flash macros as disclosed in Jha to the plug device of Margalit.

Neither Margalit nor Jha, alone or in combination, discloses all of the limitations of claims 29 and 30. Further, one of ordinary skill in the art would have no reason and not be motivated to modify the plug device of Margalit to include the set of flash macros of Jha.

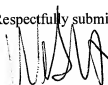
Thus Appellants respectfully submit that claims 29 and 30 is not obvious in view of Margalit and Jha and are in condition for allowance.

CONCLUSION

Appellants respectfully submit that correctly construed, claims 22-30 are supported by the written description in the specification and allowable over the cited prior art. As such, Appellants respectfully request a rehearing of the decision by the Board of Patent Appeals and Interferences and that the Board overrule all of the rejections of claims 22-30.

Dated: January 20, 2010

Respectfully submitted,



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APPENDIX A: CLAIMS APPENDIX

22. A unitary portable data storage device which can be directly plugged into a universal serial bus (USB) socket of a computer and which is operative to function as an alternative to a magnetic disk or compact disk (CD), and which is capable of storing software for installation to the computer or of receiving and storing user's data present in the computer, the unitary portable data storage device comprising:

a USB plug integrated into the unitary portable data storage device without an intervening cable capable of coupling the unitary portable data storage device directly to a USB socket on a computer;

a single interface, said interface allowing the unitary portable data storage device to communicate via the USB protocol and being coupled to the USB plug;

a non-volatile solid-state memory, said memory being non-removable from the unitary portable data storage device and having sufficient capacity to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD; and

a memory controller, the memory controller being coupled between the interface and the memory to control the flow of data between the memory and the USB plug in a manner to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD.

23. A unitary portable data storage device according to claim 22, wherein the memory controller is non-removable from the unitary portable data storage device.

24. A unitary portable data storage device according to claim 22, wherein the non-volatile solid-state memory is a flash memory.

25. A unitary portable data storage device according to claim 22, further comprising a manually operated switch movable between a first position in which writing of data to the memory is enabled, and a second position in which writing of data to the memory is prevented.

26. A unitary portable data storage device according to claim 22, wherein the memory controller comprises a micro-controller.

27. A unitary portable data storage device according to claim 26, wherein the micro-controller includes a read-only memory which stores a program to control the operation of the micro-controller.

28. A unitary portable data storage device according to claim 22, wherein the unitary portable data storage device is sufficiently compact to maximize portability.

29. A unitary portable data storage device according to claim 22, wherein the non-volatile solid-state memory is divided into a plurality of zones.

30. A unitary portable data storage device according to claim 29, wherein one or more of said plurality of zones require a unique password for access.